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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/288,415	08/10/94	BRUGGER	F 4719658A
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EXAMINER

BAWA, R

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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 30

Application Number: 08/288,415
Filing Date: 8-10/94
Appellant(s): Brugger et al.

Michael W. Glynn
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 3/28/00.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit: 1616

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 2-15.

Claim 1 has been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Claims 2-5 are unpatentable under 35 U.S.C. 103 over Gennaro in view of Stetz.

The brief includes a statement that claims 2-15 do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(5). MPEP § 1206.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 1616

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

2,815,889 STETZ et al. 7-1955

Gennaro (1985) Remington's Pharmaceutical Sciences. Mack Publishing Co.,
Easton, PA, pages 1670-1677.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gennaro, in view of Stetz et al. Gennaro discloses aerosol containers having protective coatings (p. 1670). Some examples of such coatings include oleoresin, phenolic, vinyl or epoxy coatings. It further discloses valves analogous to those claimed. Stetz et al. disclose aerosol delivery devices with metering devices analogous to those claimed.

It would be *prima facie* obvious to one of ordinary skill in the art at the time of the invention to incorporate the "protective coatings" of Gennaro into the Stetz et al. delivery device and obtain the claimed aerosol container. The motivation to incorporate these "protective coatings" is obtained from the fact that "epoxy coatings" (Gennaro) can be employed as "protective coatings" (Gennaro) in delivery devices analogous to those of Stetz et al. Hence, both the motivation and reasonable expectation of success is found in the cited prior art. The appellants' argument that Gennaro offers no indication that these coatings can be employed to inhibit pharmaceuticals is not found persuasive. Contrary to the appellants' arguments

Art Unit: 1616

concerning claim 2, the compounds disclosed by Gennaro would make obvious "a plastic coating" since they are plastics. Note that the references are evaluated by what they suggest to one versed in the art rather than their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545 (CCPA 1969).

In response to applicant's argument that Gennaro could not have been combined with Stetz et al., the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871 (CCPA 1981).

The above-mentioned claims are directed towards a composition contained in an aerosol can; its future intended use or administration is not at issue from a patentability point of view. The method of storage of the claimed aerosol is within the scope of the claimed aerosol can. There is no comparative data of record in this case that (i) presents any unexpected results over the closest prior art; or (ii) establishes any improvements over the closest prior art.

Additionally, note that: (i) the cited art is analogous because it pertains to the field of the inventor's endeavor and is also reasonable pertinent to the particular problem with which the inventor is involved. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); (ii) a comprising-type language does not exclude other steps, elements or materials. *Cues, Inc. vs. Polymer Industries*, USPQ2d 1847 (DC ND GA 1988); (iii) it is well established that the claims


Art Unit: 1616

are given the broadest interpretation during examination; and (iv) a conclusion of obviousness under 35 U.S.C. 103(a) does not require absolute predictability, only a reasonable expectation of success.

In light of the foregoing decision, the Examiner's ultimate legal conclusion is that the subject matter defined by the claims would have been obvious within the meaning of 35 U.S.C. 103(a).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




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RB/pam
July 26, 2000



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